

## **REMARKS**

Claims 1-10 and 17-20 were presented for examination, claims 11-16 being withdrawn in response to an earlier restriction requirement (dated June 22, 2006). The Office Action dated August 7, 2006 rejects claims 1-10 and 17-20. This response amends claims 1, 2, and 5-8, cancels claims 4, 9, and 11-16, and adds new claims 21-23. Claims 1-3, 5-8, 10, and 17-23 remain pending in the application.

### **Provisional Obviousness-Type Double-Patenting Rejection**

The Office Action provisionally rejects claims 1-10 and 17-20 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 5-8 of co-pending Application No. 10/812,262 in view of U.S. Patent No. 6,021,909 to Tang. Applicants respectfully traverse the provisional rejection: because (1) claims 5-8 of Application No. 10/812,262 do not claim every element and limitation of the Applicants' claimed invention, as noted by the Office Action; and (2) Tang does not disclose or suggest every element and limitation of the Applicants' amended claims that are missing from claims 5-8 of Application No. 10/812,262.

Applicants' adjustable side rail, as now set forth in representative independent claim 1, includes a tab that projects straight back from one end of the second elongate rail portion for insertion into a mounting rail hole disposed perpendicularly to the second elongate rail portion. The tab has a first side edge on one side thereof and a second side edge on an opposite side thereof. Each side edge of the tab has a notch. The notch in the first side edge catches an edge of a hole when the second elongated rail portion is coupled to a first rear mounting rail on one side of a rack and the notch in the second opposite side edge of the tab catches an edge of a hole when the second elongated rail portion is coupled to a second rear mounting rail on the opposite side of the

rack. Having notches on both sides of the tab enable the second elongated portion to be attached to a rear mounting rail irrespective of the side of the rack on which the rear mounting rail is located. This simplifies the assembly process. Personnel supplied with a kit for assembling side rails in a rack need not be concerned with whether a particular rail portion is for constructing the left side rail or the right side rail.

Tang's tab has a notch for entering and capturing an edge of a hole in a mounting rail. However, Tang's tab projects perpendicularly relative to the side rail (FIG. 4), not straight back like the Applicants' claimed tab. Thus, unlike the Applicants' invention, as now claimed, the side rail of claims 5-8 of Application No. 10/812,262 modified with Tang's tab would not be disposed perpendicularly to the hole into which the tab enters.

Further, Tang's tab does not have a notch on both sides. Consequently, modifying the side rail claimed in claims 5-8 of Application No. 10/812,262 to have Tang's perpendicular tab produces a rail portion that may be used with a rear mounting rail either on the left side of the rack or on the right side of the rack, depending on the direction of the perpendicularly projecting tab, but not both. When the side rail is flipped over for attachment to the rear mounting rail on the opposite side of the rack, the tab has no notch to catch the hole's edge. Moreover, there is no suggestion in Tang to have notches on both sides of the tab. In Tang, tabs are at both ends of the rail, which makes Tang's rail already capable of being used with a rear mounting rail on either side of the rack (i.e., there is no need to flip the rail over to for attachment to the other side). Applicants respectfully submit, therefore, that their claimed invention is non-obviousness in view of the proposed combination, and that the amendment has overcome the rejection.

**35 U.S.C. § 102(e)**

The Office Action rejects claims 1, 2, 9, and 17 as being anticipated by U.S. Patent No. 6,773,080 to Chen. Applicants respectfully traverse the rejection because Chen does not disclose every element and limitation of the Applicants' invention, as now claimed. More specifically, Chen does not disclose or suggest a tab with notches on both sides so that the second elongate rail portion can be used with a rear mounting rail on either side of a rack.

Chen's bracket device (3) hooks (34) that extend from a back end thereof. The hooks are shaped to catch the bottom edge of an assembly hole (21) in a rack (2). The bend of the hooks and the manner in which the bracket device attaches to the track assembly (1) dictate that any particular side rail can be used for either the left rear mounting rail or the right rear mounting rail, but lacks the flexibility to be used for both. This is because such hooks lack notches on both sides, unlike the Applicants' claimed tab.

For instance, FIG. 1 shows the location of the bracket device with respect to the track assembly and with a rack. Flipping the bracket device over, however, for use at the opposite rear mounting rail – so that the bracket device can be on the same side of the tracking assembly at the opposite rail, which is how multi-piece side rails are generally constructed – would cause the hooks not to function properly because the bend of the hook would face away from the bottom edge of the corresponding assembly hole. Moreover, there is no suggestion or motivation to modify Chen to have notches on both sides of a “tab”. For one, the latching mechanism on Chen's bracket device suggests that the track assembly is not intended to be flipped over when used with an opposite rear mounting rail. Secondly, Chen's hook does not lend itself to

physically having notches on both sides. Applicants respectfully submit, therefore, that Chen does not anticipate or suggest their claimed invention.

**35 U.S.C. § 102(e)**

The Office Action rejects claims 1-4 as being anticipated by U.S. Patent No. 6,893,091 to Fenner. Applicants respectfully traverse the rejection because Fenner does not disclose every element and limitation of the Applicants' invention, as now claimed.

For one, Fenner's "tab", i.e., extension (88), does not project straight back from one end of the second elongate rail portion. Rather, Fenner's extension is perpendicular to the slide rail (62). Thus, the slide rail is not disposed perpendicularly to the hole into which the extension is inserted (if the extension even enters a hole – in this respect, Fenner is unclear). Regardless of whether it enters a hole, Fenner's extension does not attach to a rear mounting rail, as set forth in the Applicants' claims.

Moreover, Fenner's extension does not have a notch formed in each side thereof. The Office Action attributes the cut-away corners of the flange to be the Applicants' notches. Although the "notches" in the flange may have formed the extension, but the structure of the extension, itself, does not actually have those notches. That is, unlike the Applicants' claimed tab, these notches are not formed in the extension; the extension cannot be said to have these notches. Applicants respectfully submit, therefore, that Fenner does not anticipate their claimed invention, and, because Fenner lacks the above-described elements and limitations, cannot be seen to even suggest it.

**35 U.S.C. § 103(a)**

The Office Action rejects claims 1-10 and 17-20 as being unpatentable over U.S. Patent Publication 2001/0040142 to Haney in view of Tang. Applicants respectfully traverse the rejection because the cited references, whether taken alone or in combination, do not disclose or suggest every claimed element and limitation of the Applicants' invention as now claimed.

Haney's side rail lacks a tab with notches. Tang, on the other hand, has a tab with a notch. However, as noted above, Tang's tab projects perpendicularly relative to the side rail, not straight back like the Applicants' claimed tab. Moreover, Tang's tab has a notch on one side only. Thus, modifying Haney's mounting bracket to have Tang's tab restricts use of the resulting mounting bracket to a rear mounting rail on one side or the other of the rack. Because of the perpendicular bend of Tang's tab and its having a notch on one side only, the resulting side rail cannot be used irrespective of the side of the rack on which the rear mounting rail is located. Further, there is no suggestion or motivation to have notches on both sides of the Tang's tab. Haney attaches the same type of mounting bracket to both ends of its rail and, therefore, already enables use with a rear mounting rail on either side of the rack.

In addition, there is no suggestion or motivation to make the proposed modification. The holes in the vertical columns in Haney's rack are not facing the proper direction to make use of Tang's tab. As noted earlier, Tang's tab extends perpendicularly from the end of the rail. The perpendicularly facing tab would not be able to enter any of the openings in the vertical rails (i.e., the tab would not be perpendicular to any of the holes). Thus, the proposed modification produces an inoperable mounting structure (at least with respect

to the tab – Haney could still mount to the column using its own flange, but the tab would be superfluous, not being able to enter any hole). Therefore, one of ordinary skill in the art in possession of Haney and Tang would not be motivated to make the proposed modification.

Each other independent claim recites language similar to that of claim 1, and therefore is patentable for at least the reasons provided in connection with claim 1. Each dependent claim depends directly or indirectly from one of the patentable independent claims, and incorporates all of its respective limitations and, therefore, is patentably distinguishable over the cited references for at least those reasons provided in connection with the independent claims. Each dependent claim also recites an additional limitation, which, in combination with the elements and limitations of its independent claim, further distinguishes that dependent claim from the cited references. Applicants respectfully request withdrawal of the rejection of these claims.

### **CONCLUSION**

In view of the amendments and arguments made herein, Applicants submit that the application is in condition for allowance and requests early favorable action by the Examiner.

If the Examiner believes that a telephone conversation with the Applicants' representative would expedite allowance of this application, the Examiner is cordially invited to call the undersigned at (508) 303-0932.

Respectfully submitted,

Date: November 6, 2006  
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